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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,393	10/31/2003	Andras Gruber	E056 1071.1	3913

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EXAMINER	
SWOPE, SHERIDAN	
ART UNIT	**PAPER NUMBER**
1656	

DATE MAILED: 10/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/699,393	GRUBER ET AL.	
	Examiner	Art Unit	
	Sheridan L. Swope	1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-58 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-58 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claims 1-58 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-8 and 13-18, 42-45, 49, drawn to a thrombin variant polypeptide, classified in class 435, subclass 226.

II. Claims 9-12, drawn to a polynucleotide encoding a thrombin variant polypeptide, classified in class 536, subclass 23.2.

III. Claims 19-41, drawn to a method treatment using a thrombin variant polypeptide, classified in class 424, subclass 94.64.

IV. Claims 46-48, drawn to a method for characterizing the antithrombotic potential of an animal using a thrombin variant polypeptide, classified in class 435, subclass 23.

V. Claims 50-55, drawn to a method for producing activated protein C using a thrombin variant polypeptide, classified in class 435, subclass 41.

VI. Claims 56-58, drawn to a method for testing the protein C activity in an individual using a thrombin variant polypeptide, classified in class 435, subclass 23.

For each of Inventions I-VI above, restriction to one of the following is also required under 35 USC 121. Therefore, election is required of one of Inventions I-VI and one of Inventions (A)-(L), as indicated.

If Invention I is elected, elect one of:

(A.) SEQ ID NO: 1

(B.) SEQ ID NO: 2

(C.) SEQ ID NO: 3

(D.) SEQ ID NO: 4

(E.) SEQ ID NO: 5

(F.) SEQ ID NO: 6

If Invention II is elected, elect one of:

(G.) SEQ ID NO: 5

(H.) SEQ ID NO: 6

If one of Inventions III-VI is elected, elect one of:

(I.) SEQ ID NO: 1

(J.) SEQ ID NO: 2

(K.) SEQ ID NO: 3

(L.) SEQ ID NO: 4

Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Also, product and process inventions are distinct if any of the following can be shown: (1) that the process as claimed can be used to make another and materially different product, (2) that the product claimed can be used in a materially different process of using that product, or (3) that the product claimed can be made by another and materially different process (MPEP § 806.05(h)). These inventions are different or distinct for the following reasons.

The polynucleotide of Invention II is related to the polypeptide of Invention I by virtue of encoding the same. The DNA molecule has utility for the recombinant production of the polypeptide in host cells. Although the DNA molecule and polypeptide are related, since the DNA encodes the specifically claimed polypeptide, they are distinct inventions because they are physically and functionally distinct chemical entities, and the polypeptide product can be made by another and materially different process, such as by synthetic peptide synthesis or purification from the natural source. Further, the DNA may be used for processes other than the production of the polypeptide, such as in a nucleic acid hybridization assay.

Inventions (A)-(L), as set forth by SEQ ID NO: 1-6, are distinct inventions because the products of said inventions are physically and functionally distinct chemical entities.

Inventions III-VI are independent because the methods of Inventions III-VI comprise different steps, utilize different products and/or produce different results.

Invention I is unrelated to Inventions III-VI because the methods of Inventions III-VI can neither use the polynucleotide of Invention I nor be used to make said polynucleotide.

The methods of Inventions III-VI are related to the polypeptide of Invention II as a product and process of using. The inventions are distinct because the polypeptide can also be used for making an antibody.

A search for more than on of Inventions I-VI would be a burden on the Office for the following reasons.

The search of Invention II would not encompass a search for Invention I, which would include searching the prior art for teachings of the purified polypeptide. Conversely, a search for Invention I, class 435, subclass 226, would not encompass a search for Invention I, which would

include searching class 536, subclass 23.2. Thus, a search of either Invention I or II would not encompass a search for the other invention and searching both inventions would be a burden on the Office.

Because the products of Inventions (A)-(L), as set forth by SEQ ID NO: 1-6, are structurally and/or functionally distinct entities, a search for one said invention would not encompass a search for any other invention and searching all of Inventions (A)-(L), or a subset thereof would be a burden on the Office.

Because the methods of Inventions III-VI comprise different steps, utilize different products, and/or produce different results, a search for one said invention would not encompass a search for any other invention and searching all of Inventions III-VI, or a subset thereof would be a burden on the Office.

A search for the polypeptides of Invention I would not encompass a search for the methods of Inventions III-VI, or vice versa, because said methods are not the only methods of making and/or using said products. Thus, a search of Invention I with any of Inventions III-VI would be a burden on the Office.

A search for the polynucleotide of Invention II would not encompass a search for the methods of Inventions III-VI, or vice versa, because said methods neither make nor use said polynucleotide. Thus, a search of Invention II with any of Inventions III-VI would be a burden on the Office.

These inventions are distinct for the reasons given above and have acquired a separate status in the art due to their recognized divergent subject matter, as shown by their different

classification. Furthermore, as explained above, searching more than one invention would be a burden on the Office. Therefore, restriction for examination purposes, as indicated, is proper.

Restriction between product and process claims has been required. Where Applicant elects claims directed to a product, and the product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the Official Gazette notice dated March 26, 1996 (1184 O.G. 86; see also M.P.E.P. 821.04, *In re* Ochiai, and *In re* Brouwer). Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right, if the amendment is presented prior to final rejection or allowance, whichever is earlier. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. To be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheridan L. Swope whose telephone number is 571-272-0943. The examiner can normally be reached on M-F; 9:30-7 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published application may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sheridan Lee Swope, Ph.D.

Art Unit 1656